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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/867,587	05/31/2001	Bill Kitchen	3350-05E	8050

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EXAMINER
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ALVAREZ, RAQUEL

ART UNIT	PAPER NUMBER
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3622

DATE MAILED: 11/03/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

09/867,587

Applicant(s)

KITCHEN ET AL.

Examiner

Raquel Alvarez

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 13 August 2003.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 34-53 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 34-53 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

## Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

**DETAILED ACTION**

1. This office action is in response to communication filed on 8/13/2003.

**Claim Rejections - 35 USC § 102**

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

2. **Claims 34-38, 40-47 and 49-53 are rejected under 35 U.S.C. 102(b) as being anticipated by Hogan (5,699,528 hereinafter Hogan).**

With respect to claim 34, Hogan teaches a method for presenting billing information (Abstract). Transmitting a notice according to an e-mail protocol via a network, indicating availability of billing information (i.e. the user receives an e-mail through a mail server via a network to bring a bill to the subscriber's attention; the e-mail containing the URL of the bill service company) (col. 5, lines 53-61); transmitting a request according to a protocol other than e-mail protocol, via the network, to receive the billing information responsive to receipt of the notice (i.e. the user via a web server connects to the bill service site by clicking on the URL of the particular bill service company to view the content of the billing information) (col. 4, lines 14-22 and col. 5, lines 44-, col. 6, lines 1-30); transmitting at least a portion of the billing information, via

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the network, responsive to receipt of the request (i.e. the user receives the billing information pertaining to the user's requests via the web) (col. 6, lines 11-30).

With respect to claim 35, Hogan further teaches formatting the billing information for presentation responsive to receipt of the request (see Figure 11).

With respect to claim 36, Hogan further teaches formatting the billing information for presentation prior to transmitting the notice (i.e. device 150 collects and processes bill images from participating payees, and the images are created prior to sending the bill notice to the customer (col. 4, lines 53-67); storing the formatted billing information (i.e. the formatted billing information is stored and transmitted from device 150 to the server which would allow the user to access their bill information)(col. 5, lines 1-10); wherein the transmitted billing information is the stored formatted billing information (col. 5, lines 1-10 and col. 9, lines 50-54).

With respect to claims 37-38, Hogan further teaches that the notice includes information indicating a location of the available information is a hyperlink and selecting the hyperlink to transmit the request (i.e. the e-mail message received by the user contains a web site location (hyperlink) and the user selects the hyperlink to transmit his interest in viewing the billing information)(col. 4, lines 14-22 and col. 5, lines 44-, col. 6, Lines 1-30).

With respect to claims 40, Hogan teaches a method for transmitting billing information (Abstract). Transmitting, via the a network, an e-mail notice indicating availability of billing information (i.e. the user receives an e-mail over network 100 containing a message header about stored electronic bills)(Figure 1 and col. 9, lines 7-19); transmitting, via the network, an e-mail request to receive the billing information responsive to receipt of the notice (i.e. an acknowledgement message through network 110 is sent indicating the user's request to receive the billing information)(col. 9, lines 61-64) and transmitting, via the network, at least a portion of the billing information responsive to receive of the request (i.e. the billing information responsive to the user's request is transmitted to the user)(see Figures 10-11).

With respect to claim 41, is similar in scope as claim 35 rejected above and therefore is rejected under similar rationale.

With respect to claim 42, is similar in scope as claim 36 rejected above and therefore rejected under similar rationale.

Claim 51 is substantially similar to claim 40 and therefore is rejected under similar rationale.

With respect to claim 43, Hogan teaches a method for presenting billing information (Abstract). Transmitting, via a network, a notice indicating availability of

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billing information, the notice transmitted according to a network other than e-mail (i.e. When the user visits the bill payment web site and enters the correct userID and password, the user receives a display indicating the availability of stored billing information) (Figure 3 and col. 6, lines 9-16); transmitting, via the network, a request to receive the billing information responsive to receipt of the notice, the request also transmitted according to a protocol other than e-mail (i.e. the user selects the EBSC's bill payment web site to request the billing information (col. 5, lines 62- , col. 6, lines 1-30); and transmitting, via the network, at least a portion of the billing information responsive to receipt of the request (i.e. the billing information responsive to the user's request is transmitted to the user)(col. 6, lines 11-30).

With respect to claim 44 is similar in scope as claims 35 and 41 therefore rejected under similar rationale.

With respect to claim 45 is similar in scope as claims 36 and 42 and therefore rejected under similar rationale.

Claims 46-47 are similar in scope as claims 37-38 rejected above and therefore rejected under similar rationale.

With respect to claim 49, Hogan further teaches that the second network protocol is the same as the first network protocol (i.e. the transmission of the notice and the response to the notice are being conducted through the Internet network)(see Figure 1).

Claim 50 is similar in scope as claim 34 rejected above and therefore rejected under similar rationale.

Claim 52 is similar in scope as claim 43 rejected above and therefore rejected under similar rationale.

Claim 53 is similar in scope as claim 49 rejected above and therefore rejected under similar rationale.

**Claim Rejections - 35 USC § 103**

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

**3. Claims 39 and 48 are rejected under 35 U.S.C. 103(a) as being unpatentable over of Hogan (5,699,528 hereinafter Hogan) in view of Bezos (6,029,141 hereinafter Bezos).**

With respect to claims 39 and 48, the claims further recite that the hyperlink is an icon. Hogan teaches that the hyperlink is an URL. Hogan does not specifically teach that the hyperlink is an icon. On the other hand, Bezos teaches an Internet-based customer referral system wherein the hyperlink is a graphic icon 600 which allows the customers to click on the icon with a mouse in order to link to a web site (Figure 6, item 600). It would have been obvious to a person of ordinary skill in the art at the time of Applicant's invention to have included the hyperlink of Hogan to be an icon as taught by Bezos because such a modification would allow for the users to see a visual representation of the hyperlink.



**Response to Arguments**

4. The objection to the specification and the 112 rejection have been withdrawn in lieu of Applicant's amendments.

5. The Applicant argues that the e-mail of Hogan is not a notice of availability of billing information rather a notice to inform subscriber of a pending bill due date. The Examiner asserts that in Hogan the e-mail is sent from server computer 160, the server computer 160 having access to subscriber billing data. It seems that the e-mail received contains certain information on the bill that is due and instruct the customer on how to access the bill payment data through server computer 160 in order for the customer to receive additional information on the bill that is due by instructing the customer to log into the EBSC's bill payment website (col. 5, lines 62-, col. 6, lines 1-31).

6. Applicant argues that Hogan does not disclose a first and a second network server. Examiner respectfully disagrees with Applicant because Hogan clearly teaches an e-mail server in addition to server computer 160.

7. With respect to arguments to claim 35, the claim recites "that in response of the request of the billing information formatting the bill". The claim doesn't recite that the bill is formatted on the fly. The claim limitation is met by Hogan because in Hogan the user receives an e-mail reminder of the bill that is due and the user is instructed to visit the EBSC website and based on the user requesting the bill information from the website the bill is presented to the user (col. 5, lines 62-, col. 6, lines 1-31).

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8. With respect to the interpretation of Figure 3, the Examiner agrees with the Applicant that Figure 3 depicts a home page of the bill service presented via the World Wide Web. The Examiner wants to point out that the network protocol is the Internet (World Wide Web) which is a network other than the e-mail network. Detail 203 links the user to the available billing information. The Examiner respectfully disagrees with Applicant that Hogan doesn't teach in Figure 3 a notice of available bill information. The Examiner asserts that a notice is merely used to bring attention to a particular subject. In Figure 3 all the detail items 201, 203, 205, 207, 209 and 211 are all notices or subject which are brought to the user's attention. By allowing the user to receive and pay bills (detail 203) the system is in fact bringing to the user's attention the billing information available.

9. In response to applicant's argument that Bezos is nonanalogous art, it has been held that a prior art reference must either be in the field of applicant's endeavor or, if not, then be reasonably pertinent to the particular problem with which the applicant was concerned, in order to be relied upon as a basis for rejection of the claimed invention. See *In re Oetiker*, 977 F.2d 1443, 24 USPQ2d 1443 (Fed. Cir. 1992). In this case, Hogan and Bezos are both solving the same particular problem which is displaying a hyperlink as an icon to indicate a particular location containing the specified information.

10. The examiner asserts that Hogan in combination with Bezos teaches the claimed invention.

**Point of contact**

11. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Raquel Alvarez whose telephone number is (703)305-0456. The examiner can normally be reached on 9:00-5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Eric w Stamber can be reached on (703)305-8469. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703)308-1113.

Raquel Alvarez  
Examiner  
Art Unit 3622

R.A.  
10/22/03

A handwritten signature in black ink, appearing to read "Eric W. Stamber". The signature is stylized with a large, looped "E" and a cursive "Stamber".

ERIC W. STAMBER  
SUPERVISORY PATENT EXAMINER  
TECHNOLOGY CENTER 3600